2001); *Verdegaal Bros., Inc. v. Union Oil Co.,* 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Moreover, anticipation under section 102 is only valid when a reference shows exactly what is claimed; where there are differences between the references disclosures and the claim, a rejection must be based on obviousness under Section 103. *Richardson v. Suzuki Motor Co., Ltd.*, 868 F.2d 1226, 9 USPQ2d 1913 (Fed. Cir. 1989).

As discussed in *Feingold*, each embodiment of the IOL requires a lens body portion (12, 22, 32, 42, 52, 72 and 82) and a lens portion (14, 24, 34, 44, 54, 74 and 84). In contrast, Applicant's inventive corneal implant of claim 1 includes a lens body having two surfaces that are bi-meniscus in shape and joining each other at the periphery of the lens. Clearly *Feingold* does not teach a lens body with two surfaces "bi-meniscus in shape" and "joining each other at the periphery of the lens."

Moreover, the edge thickness of the Applicant's inventive corneal implant, being less than about 15 micrometers, is designed to prevent stacking and recruitment of keratocytes in the lens material. This designed thickness of Applicant's corneal implant in turn eliminates unorganized collagen. This unorganized collagen, if not prevented, may form undesirable scar tissue and infiltrate the corneal implant. In contrast to Applicant's corneal implant, the Feingold device is an IOL intended for intraocular placement behind the iris. No indication or teaching is made that Feingold's IOL may be implanted within the cornea. As such, no necessity exists for an edge thickness in *Feingold's* IOL of less than about 15 micrometers. Such an edge thickness for an IOL for use behind the iris may in fact be undesirable or even problematic.

Lastly, Applicant respectfully disagrees that *Feingold* inherently discloses or teaches an edge thickness Te of about about 0.015 micrometers. As stated in *Feingold*, Tc is used a symbol for the thickness of the lens portion. As noted above, Feigngold's IOL requires both a lens portion and a lens body portion. As illustrated in Figs. 1,4, 8, 11, 16, 19 and 21, the symbol Tc does not include the thickness of the lens body portion. An extrapolation from Tc to Te, therefore can not be made since Tc has no direct or indirect relationship to Te.

Applicant respectfully contends that claim 1 and dependent claims 2-3, 5 and 10 are patentable over *Feingold.* In view of the above, Applicant respectfully requests that this rejection under § 102(e) be withdrawn. Accordingly, for the reasons set forth above, claims

1-3, 5 and 10 are in condition for allowance.

Obviousness under 35 U.S.C. 103(a) as being unpatentable over Feingold (U.S. Patent 5,913,898) in view of Wichterle (U.S. Patent 4,971,732)

Claims 4 and 6-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Feingold (U.S. Patent 5,913,898) in view of Wichterle (U.S. Patent 4,971,732).

In order to establish a *prima facie* case of obviousness, three basic criteria must be met: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; (2) there must be a reasonable expectation of success; and (3) the prior art reference (or references when combined) must teach or suggest all the claim limitations. *Manual of Patent Examining Procedure* § 2142. *See also In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q. 2d 1438 (Fed Cir. 1991) (emphasizing that the teaching or suggestion to make the claimed combination and the reasonable expectation of success must be both found in the prior art, and not based on applicant 's disclosure).

Claims 4 and 6-9 depend either directly or indirectly from claim 1. The discussion of the *Feingold* reference above (which is hereby reasserted as to the obviousness rejection) shows that the *Feingold* actually teaches away from, rather then towards Applicant's corneal implant. The *Witchterle* references teaches an intraocular lens to be implanted in the **posterior chamber** after cataract operation. The *Witchterle* and *Feingold* references do not inherently or expressly teach, alone or in combination, insertion of the intraocular lens into the cornea. Both the *Witchterle* and *Feingold* references teach an intraocular lens for implantation into to the **posterior chamber**.

Moreover, the *Witcherle* reference teaches a bi-convex posterior chamber lens, whereas Applicants corneal implant is bi-meniscus in shape. Additionally, the *Witcherle* lens is designed as a replacement lens for the human crystaline lens. The *Wichterle* lens teaches away from Applicant's corneal implant as described in claim 1.

Applicant respectfully contends that claims 4 and 6-9 are patentable over *Witcherle* and *Feingold*, alone and in combination. In view of the above, Applicant respectfully requests that this rejection under § 103(a) be withdrawn. Accordingly, for the reasons set

forth above, claims 4, and 6-9 are in condition for allowance.

Obviousness under 35 U.S.C. 103(a) as being unpatentable as being unpatentable over Choyce (U.S. Patent 4,655,774).

Claims 11-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Choyce* (U.S. Patent 4,655,774).

The *Choyce* and *Wichterle* references do not alone, or in combination teach, disclose or otherwise make obvious Applicant's claimed method. Claim 11 requires that the lens be formed of an optically clear an optically clear, biocompatible, material having an index of refraction substantially the same as that of corneal tissue, the body being solid and having two surfaces that are bi-meniscus in shape and joining each other at the periphery of the lens, the thickness of the edge being less than about 15 micrometers. Claims 12-17 depends either directly or indirectly from claim 11.

The *Choyce* reference teaches an implant intended to act in place of an iris. The Choyce reference does not discuss that the *Choyce* iris implant has an index of refraction substantially the same as that of the corneal tissue, nor does the reference discuss that the thickness of the edge be less than about 15 micrometers.

Also, no motivation exists to combine the *Choyce* iris implant with the *Wichterle* intraocular **posterior chamber** lens. As discussed above, the *Witcherle* reference teaches a bi-convex posterior chamber lens, whereas Applicant's corneal implant described in claim 11 is bi-meniscus in shape. Additionally, the *Witcherle* lens is designed as a replacement lens for the human crystaline lens.

Moreover, no indication or teaching is made that the *Wichterle* lens may be implanted within the cornea. As such, no necessity exists for an edge thickness in *Wichterle* lens of less than about 15 micrometers as is required in Applicant's method of claim 11. Such an edge thickness for an a posterior chamber lens replacing the crystaline lens may in fact be undesirable or even problematic. The *Wichterle* reference teaches away from Applicant's method as described in claim 11.

Applicant respectfully contends that claims 11-17 are patentable over *Choyce* and *Wichterle*, alone and in combination. In view of the above, Applicant respectfully requests that this rejection under § 103(a) be withdrawn. Accordingly, for the reasons set forth above, claims 11-17 are in condition for allowance.

Attached hereto is a marked-up version of the changes made to the specification and claims by the current amendment. The attached page is captioned "**Version with markings to show changes made.**"

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 06-2375, under Order No. HO-P01709US6 from which the undersigned is authorized to draw.

Dated: JANUARY 29, 2003

Respectfully submitted,

By _____

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